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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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BLAKELY SOKOLOFF TAYLOR & ZAFMAN  
12400 WILSHIRE BOULEVARD, SEVENTH FLOOR  
LOS ANGELES, CA 90025

EXAMINER

CASAREGOLA, LOUIS J

ART UNIT	PAPER NUMBER
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3746

DATE MAILED: 07/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/895,569

Applicant(s)

PAPAMOSCHOU, DIMITRI

Examiner

Louis J. Casaregola

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 2-3, 6, 8, 10-11, 13, 29-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-5, 7, 9, 12, 14-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/29/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

***Preliminary Amendment***

This case is a reissue application of Patent 5,916,127, and it was filed with a preliminary amendment that is not in full compliance with 37 CFR 1.173. Claims 1 and 11 include instances of language differing from that in the '127 Patent but not underlined and/or bracketed as required by § 1.173 (d). In claim 1, line 9, “;” has been replaced with “, and”, and in claim 11, line 1, “10” has been replaced by “1”. The Preliminary Amendment has been entered for the purposes of examination but it must be resubmitted in proper format.

***Restriction Requirement***

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 1-28, drawn to a jet engine, classified in Class 60, subclass 226.1,  
and
- II. Claims 29-34, drawn to a method of operating a jet engine, classified in  
Class 60, subclass 204.

The inventions of Groups I and II above are distinct because the jet engine apparatus of Group I could be operated according to a method materially different than that of Group II. The broadly recited Group I apparatus in the form of a mechanism for controlling temperature or velocity in one of the exhaust streams does not necessarily

provide control of Mach wave formation as required by the Group II method. Mention of this phenomenon in the apparatus claims merely constitutes a desired result, and the claimed apparatus could be operated without producing such a result.

Because these inventions are distinct for the reasons given above and require separate classification and/or divergent fields of search, restriction for examination purposes as indicated is proper.

As noted above, this case is a reissue application of Patent 5,916,127, and that patent includes no method claims corresponding to the invention of Group II. The invention of Group I has thus been constructively elected by original presentation as provided for under 37 CFR 176(b), and Group II claims 29-34 are withdrawn from consideration.

### ***Species Election***

The parent '127 Patent in this case issued from Application 08/688,622, which was subject to a species election requirement (copy attached as Exhibit A). Applicant subsequently elected the species comprising the engine system of Figure 1 along with the exhaust configuration of Figure 7A. Seven claims, corresponding essentially to present claims 2, 3, 6, 8, 10, 11, and 13, were then withdrawn from consideration as directed to non-elected species. These claims were later rejoined with the active claims upon allowance of a generic parent claim corresponding to claim 1 in '127 Patent. The

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present reissue application has however significantly broadened claim 1 to the extent that it is no longer considered allowable. Since claims directed to non-elected species no longer depend from an allowed generic claim, the original species election requirement is effectively reactivated, and non-elected claims 2, 3, 6, 8, 10, 11, and 13 revert to their withdrawn status.

The claims now active in this case are 1, 4, 5, 7, 9, 12, and 14-28. An examination of these claims is set forth below.

### ***Objections – 37 CFR 1.178***

The present reissue application is objected to under 37 CFR 1.178(a) for failing to be accompanied by either the original patent or an offer to surrender the original patent.

### ***Defective Reissue Declaration***

The reissue declaration filed with this application is objected to because it fails to identify at least one specific error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414. Note that a nominal statement to the effect that the patentee is claiming less than he has a right to claim is not adequate for this

purpose. An error in the claims must be identified by reference to specific claim(s) and specific claim language.

Claims 1, 4, 5, 7, 9, 12, and 14-28 are rejected under 35 U.S.C. 251 as being based upon a defective reissue declaration as set forth above.

### ***Rejections – Recapture***

Claims 1, 4, 5, 7, 9, 12, and 20-27 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. A broadening aspect is present in the reissue which was not present in the application for the patent. The record of Application 08/688,622 shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The claimed invention allowed in the '622 application comprises a jet engine with two adjacent exhaust streams distinguished by the fact that one was supersonic and the other was subsonic. This feature was specifically emphasized by claim amendments in

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applicant's paper filed 11/10/97 for the purpose of overcoming a rejection over prior art; i.e. the cited patents to Wolf et al and/or Hazen et al. The present claims have been broadened to the extent that they now lack a specific limitation requiring that the two exhaust streams are respectively supersonic and subsonic. This broadening of the claims thus constitutes an improper attempt to recapture subject matter surrendered in the application for the patent upon which the reissue is based.

***Claim Rejections - 35 USC § 112***

Claims 20 and 21 are rejected under 35 U.S.C. § 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

New claims 20 and 21 state that the temperature/velocity control mechanism recited in parent claim 1 "controls velocity of turbulent eddies of the first stream to be subsonic". It is not seen how this limitation applies to the apparatus presently claimed. The preferred embodiment of the invention as shown in Figure 1 operates to either control temperature using suppression burners 34, or to control overall stream velocity using one of the techniques described in column 8, last paragraph. This feature how-

ever is applied to the second stream , i.e. stream 32, rather than the first stream as suggested by the claims. Furthermore, there is in fact nothing in the claims or the disclosure that appears actually capable of providing direct control of eddy velocity in either stream. Claim language referring to control of this parameter merely suggests an indirect, desired result which has no clear limiting effect on the claimed apparatus.

***Claim Rejections - 35 USC § 102***

Claims 1, 4, 5, 7, 9, 12, 20, 21, and 25-27 are rejected under 35 U.S.C. § 102(b) as being anticipated by Wolf et al or Hazen et al.

The present claims are so broad as to read on any jet engine having multiple working fluid streams and a combustor or other device that can change the temperature of at least one stream. Such features can be found in almost all turbofan engines including those disclosed by Wolf and Hazen. The so-called "control mechanism to control at least one of temperature and velocity of at least one of the first and second streams" reads on either main combustor 36 and/or bypass duct combustor 54 of Wolf and on main combustor 14 and/or bypass duct combustor 65 of Hazen. Note also that claim language referring to the temperature/velocity control mechanism as being "to control Mach waves..." merely sets forth an intended use or desired result. There is



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nothing, moreover, in the broadly recited structure that renders the claimed invention any more capable of Mach wave control than the prior art.

L. J. Casaregola  
703-308-1027 (M-F; 8:00-4:30)  
703-872-9302 FAX (9303 After Final)  
June 12, 2002

  
**LOUIS J. CASAREGOLA**  
**PRIMARY EXAMINER**

Serial Number: 08/688,622  
Art Unit: 3403

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Exhibit A

Exhibit A

**Species Election**

This application encompasses numerous different species of a generic invention. There are least seven alternative engine systems for establishing multiple exhaust streams. These include the systems of Figure 1, Figure 2, Figure 3, Figure 4, Figure 5, Figure 6, and a seventh embodiment (not shown) employing a variable pressure ratio fan as in claim 24. (There may be further alternative systems based on combinations of the seven systems previously listed.) There are also 6 alternative exhaust end configurations as shown respectively in Figure 7a, Figure 7B, Figure 8A, Figure 8B, Figure 8C, and Figure 8D. Pursuant to 35 USC § 121, applicant is required for a complete response to elect a single species by selecting one of the alternative engine systems and further selecting one of the alternative exhaust end configurations. The combination of the selected engine system and selected end configuration will constitute the elected species. Applicant is further required to list all claims readable on the elected species including any claims subsequently added (MPEP 809.02(a)).

It is unclear whether any of the present claims are fully generic to all species. Applicant is advised however that a mere argument alleging that a generic claim exists or is allowable will not satisfy the species election requirement.